


TRANSMITTAL OF APPEAL BRIEF			Docket No. 04981-00532-US
In re Application of: Teresa Ancona et al.			
Application No. 10/518,729-Conf. #3186	Filing Date December 20, 2004	Examiner J. V. Lewis	Group Art Unit 3722
Invention: EMBOSSED MARKING			
<u>TO THE COMMISSIONER OF PATENTS:</u> Transmitted herewith is the Appeal Brief in this application, with respect to the Notice of Appeal filed: <u>March 9, 2009</u> . The fee for filing this Appeal Brief is <u>\$ 540.00</u> . <input checked="" type="checkbox"/> Large Entity <input type="checkbox"/> Small Entity <input type="checkbox"/> A petition for extension of time is also enclosed. The fee for the extension of time is _____ . <input type="checkbox"/> A check in the amount of _____ is enclosed. <input type="checkbox"/> Charge the amount of the fee to Deposit Account No. <u>03-2775</u> . <input checked="" type="checkbox"/> Payment by credit card. Form PTO-2038 is attached. <input checked="" type="checkbox"/> The Director is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. <u>03-2775</u> . This sheet is submitted in duplicate.			
<div style="text-align: center;">  Richard M. Beck Attorney Reg. No. : 22,580 CONNOLLY BOVE LODGE & HUTZ LLP 1007 North Orange Street P. O. Box 2207 Wilmington, Delaware 19899-2207 (302) 658-9141 </div>		Dated: <u>05-11-09</u>	

Docket No.: 04981-00532-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Teresa Ancona et al.

Application No.: 10/518,729

Confirmation No.: 3186

Filed: December 20, 2004

Art Unit: 3722

For: EMBOSSSED MARKING

Examiner: J. V. Lewis

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

As required under § 41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on March 9, 2009, and is in furtherance of said Notice of Appeal.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1205.2:

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| I. | Real Party In Interest |
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| VII. | Argument |
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X. Related Proceedings Appendix

I. REAL PARTY IN INTEREST

The real party in interest is Philip Morris USA Inc. by virtue of an assignment duly recorded in the Patent and Trademark Office on May 3, 2005, at Reel 016188 Frame 0226 (5 pages).

II. RELATED APPEALS AND INTERFERENCES

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 11 claims pending in application.

B. Current Status of Claims

1. Claims canceled: 0
2. Claims withdrawn from consideration but not canceled: 0
3. Claims pending: 1-11
4. Claims allowed: 0
5. Claims rejected: 1-11

C. Claims On Appeal

The claims on appeal are claims 1-11

IV. STATUS OF AMENDMENTS

Applicant did not file an Amendment After Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Single Independent Claim 1

With reference to US 2005-0206159 A1, the publication of the present application, the invention herein relates to a packaging material (1) made of at least a first sheet (2) and a second sheet (3) each having two opposite faces (21, 22, 31, 32) designated as front (21, 31) and back (22, 23) faces where at least one of these faces bears legible printed information (4). (Paragraphs 1-2; Figure 3). In addition to the printed information (4), at least one of the front faces (21, 31) has legible information (5) which distinct from the information (4) is made in the form of reliefs (51) which appear superimposed on the information (4) without changing the legibility of that information. (Paragraph 8; Figures 3 and 5).

Dependent Claims 2-4

The information in relief (5) of claim 1 may be formed by (A) local deformation along the thickness of at least one of the first and second sheets (2, 3) (claim 2) (Paragraph 28; Figure 3); (B) deposit of an element in relief (52) on at least one of the front faces (21, 31) of at least one of the first and second sheets (2, 3) (claim 3) (Paragraph 30; Figure 5); or (C) local modification of the state of the surface of at least one of the front faces (21, 31) of at least one of the first and second sheets (2, 3) (claim 4) (Paragraphs 34-35).

Dependent Claim 5

The material (1) of claim 4 may include a single sheet selected from one of the first and second sheets wherein the printed information (4) and relief (5) are both borne by such single sheet. (Paragraph 38; Figure 2).

Dependent Claim 6

The material (1) of claim 4 may include at least two sheets (2, 3) where the sheet (2) is opaque and the front face (21) thereof bears the printed information (4). The second sheet (3) is transparent and the front face (31) bears the information in relief (5). Alternatively, the information in relief (5) may be superimposed on the front face (21) of the first sheet that bears the printed information (4). (Paragraphs 39-43; Figure 3).

Dependent Claim 7

The material (1) of claim 4 includes at least two sheets (2, 3) where the second sheet (3) is opaque and the front face (31) thereof bears the information in relief (5). The first sheet is transparent and flexible and bears the printed information (4) on the front face (21) thereof, and the first sheet (2) is superimposed on the front face (31) of the second sheet (3) with the relief (5) thereon. (Paragraphs 47-51; Figure 4).

Dependent Claim 8

The material (1) of claim 4 includes at least two sheets (2, 3) where the second sheet is opaque and the front face (31) thereof bears the information in relief (5). The first sheet (2) is opaque and flexible and bears the printed information (4) on the front face (21) thereof, and the first sheet (2) is superimposed on the front face (31) of the second sheet (3) with the relief (5) thereon. (Paragraphs 53-58; Figure 5).

Dependent Claims 9, 10 and 11

At least a part of the material (1) of claim 8 may be used in forming a receptacle (claim 9), a lining for a receptacle (claim 10), or an outer wrapping for a receptacle (claim 10). (Paragraphs 59-64).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1. Whether or not claims 1, 3, 5-8 and 11 are patentable under 35 USC §103(a) over U.S. Patent Publication No. 2001/0035645 to Carides et al in view of Fukumoto US 5,779,482?

2. Whether or not claims 2 and 4 are patentable under 35 USC §103(a) over U.S. Patent Publication No. 2001/0035645 to Carides et al in view of Fukumoto US 5,779,482 and Bright US 5,753,350?

3. Whether or not claims 9 and 10 are patentable under 35 USC §103(a) over U.S. Patent Publication No. 2001/0035645 to Carides et al in view of Fukumoto US 5,779,482 and Summers US 5,566,823?

VII. ARGUMENT

Appellant respectfully submits that the subject matter of claims 1-11 is neither shown nor suggested by the prior art taken alone or in combination. Specifically, claims 1, 3, 5-8 and 11 are not rendered obvious by the combination of Carides et al US 2001/0035645 ("Carides") and Fukumoto US 5,779,482, for the reasons discussed below. Also, claims 2 and 4 are not rendered obvious by the combination of Carides, Fukumoto and Bright US 5,753,350, and claims 9-10 are not rendered obvious by Carides, Fukumoto and Summers US 5,566,823, for the reasons expressed below.

The primary Carides reference simply discloses a very common label assembly that includes multiple plies of flexible material some of which are transparent and some of which contain printed indicia. Presumably the invention resides in water-insoluble features, and as such Carides has little bearing on the key features of the present invention. Carides is significantly different from the present invention in that it simply comprises a label structure that includes three plies of material, namely a base ply 14, a middle ply 22 and an outside ply 26. These plies are efficiently laminated to one another to form a single assembly 10 which may be attached to a substrate such as a bottle B. The middle ply 22 includes printed material and the base ply 14 is sealed to

outer ply 26 with the printed ply therebetween. Nothing more is shown, and clearly there is no disclosure or suggestion of appellant's legible information 5 distinct from the printed information 4 and made up in the form of reliefs 51.

In the outstanding rejections the Examiner relies upon Fukumoto for appellant's claimed legible information in the form of reliefs, but there is no suggestion for adding anything to the outside or elsewhere on the label structure of Carides. Clearly the Examiner's conclusion that it would be obvious

"to provide the Fukumoto information in relief on the Carides second sheet front face, such that it is superimposed on the front face of the first sheet that bears the printed information, in order to enable both healthy persons and the visually handicapped to understand designs formed on the sheet",

is nothing more than speculation and prohibited hindsight application of appellant's own teachings, which is grossly unfair to appellant. As the Examiner is well aware, these are impermissible bases for sustaining a rejection. Without any suggestion for the formulated combination of Carides and Fukumoto, the Examiner is resorting to prohibited hindsight while improperly utilizing the present disclosure as the blue print for such profound and unsupported rearrangements of the prior art.

In determining patentability one must look to the invention as a whole as well as the features which distinguish the invention and produce the beneficial results achieved by those features. While the applied prior art generally may be somewhat analogous, such prior art does not suggest the claimed invention, and the Examiner simply has combined bits and pieces of the art without any suggestion to do so in a failed attempt to reconstruct the prior art in manner it was not intended to be reconstructed. The Examiner has failed to set forth a prima facie case of unpatentability consistent with 35 USC §103(a) and the applicable case law.

With respect to the subject matter of claims 2 and 4, appellant is the first to admit that embossing or other ways of deforming a substrate is old in the art, but the

deformation recited in claim 2 and the surface modification recited in claims 4 are in the context of both printed information 4 and legible information 5 in the form of reliefs which cooperate with one another so that the reliefs appear to be superimposed on the printed information. Figure 4 of Bright is significant in that it shows a label 60 including printed information as well as ridges 70, but the printed information and ridges are distinct and separate from one another. They do not cooperate with one another and the ridges do not appear to be superimposed on the printed material. Moreover, Carides and Fukumoto are deficient for the reasons expressed above, and Bright does not address those deficiencies.

The packaging and receptacle inner liner of claims 9 and 10 both include the material of claim 8. Summer simply discloses a toothbrush holder having Braille markings on a tray 16 found within the interior of the holder. Clearly there is no teaching or suggestion of appellant's printed information and further information in the form of reliefs both of which cooperate with one another so that the reliefs appear to be superimposed on the printed information without changing the printed information. The combination of Carides and Fukumoto falls short for the reasons discussed above. Equally significant is that there is no suggestion or motivation to alter the structure of Summers in the manner stated by the Examiner during the prosecution.

Although not controlling, it should be noted that many foreign counterparts of the present application have been granted with claims of similar scope as noted on the attached Patent Family Record Sheet for FTR0211 which is the assignee's matter number for the present application and the listed foreign counterparts.

In view of the above argument, it is submitted that claims 1-11 are indeed patentable over the prior art, and it is respectfully requested that the rejection of these claims be reversed.

VIII. CLAIMS APPENDIX

A copy of the claims involved in the present appeal is attached hereto as the Claims Appendix.

IX. EVIDENCE APPENDIX

See the attached Evidence Appendix.

X. RELATED PROCEEDINGS APPENDIX

See the attached Related Proceedings Appendix.

Respectfully submitted,

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VIII. CLAIMS APPENDIX

Claims Involved in the Appeal of Application Serial No. 10/518,729

Claim 1: Material (1) made up of at least a first (2) and a second (3) sheet each having two opposite faces (21, 22, 31, 32) designated as front (21, 31) and back (22, 32) faces, at least one (21, 31) of these faces being intended to bear legible printed information (4),

this material being characterised in that, in addition to the printed information (4), at least one of said front faces (21, 31) bears legible information (5) which, distinct from the printed information (4), is made up in the form of reliefs (51) which appear to be superimposed on the legible printed information (4) without changing the legibility of the printed information.

Claim 2: Material according to claim 1, characterised in that the information in relief (5) is formed by local deformation along the thickness of at least one of the first and second sheets (2, 3).

Claim 3: Material according to claim 1, characterised in that the information in relief (5) is formed by deposit of an element in relief (52) on at least one of said front faces (21, 31) of at least one of said first and second sheets (2, 3).

Claim 4: Material according to claim 1, characterised in that the information in relief (5) is composed by local modification of the state of the surface of at least one of said front faces (21, 31) of at least one of said first and second sheets (2, 3).

Claim 5: Material according to claim 4, characterised in that the material (1) includes a single sheet (2) constituted by one (2) of said first and second sheets (2, 3), and the printed information (4) as well as the information in relief (5) are borne by this sheet (2).

Claim 6: Material according to claim 4, characterised in that it includes at least two sheets (2, 3) constituted by said first and second sheets (2, 3), of which:

- said first sheet (2) is made up of opaque material and whose said front face (21) bears the printed information (4),
- said second sheet (3) is made up of transparent material, and
 - on the one hand, at least whose said front face (31) bears the information in relief (5), and
 - on the other hand, is superimposed on the front face (21) of the first sheet (2) that bears the printed information (4).

Claim 7: Material according to claim 4, characterised in that it includes at least two sheets (2, 3) constituted by said first and second sheets (2, 3), of which:

- said second sheet (3) is made up of opaque material and whose said front face (31) bears the information in relief (5),
- said first sheet (2) is made up of transparent and flexible material and
 - bears the printed information (4) at least on its front face (21), and
 - is superimposed on the front face (31) of said second sheet (3) which bears the information in relief (5).

Claim 8: Material according to claim 4, characterised in that it comprises at least two sheets (2, 3) constituted by said first and second sheets (2, 3), of which:

- said second sheet (3) is made up of opaque material and whose said front face (31) bears the information in relief (5),
- said first sheet (2) is made up of opaque and flexible material, and

- bears the printed information (4) at least on its front face (21), and
- is closely superimposed on the front face (31) of said second sheet (3) which bears the information in relief (5).

Claim 9: Packaging comprising a receptacle, characterised in that this receptacle is made up at least in part of a material according to claim 8.

Claim 10: Inner lining for a receptacle, characterised in that it is made up at least in part of a material according to claim 8.

Claim 11: Outer wrapping for a receptacle characterised in that this outer wrapping is made up at least in part of a material according to claim 8.

IX. EVIDENCE APPENDIX

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

X. RELATED PROCEEDINGS APPENDIX

No related proceedings are referenced in II. above, hence copies of decisions in related proceedings are not provided.

Patent Family Record Sheet

File ID: FTR0211
 Short Title: Embossed Labelling
 Inventor(s): Teresa Ancona ; Tony Manganeli
 Cost Center(s):
 PM Attorney: Stefan Kaiser

File ID	OP	Reg.System	Origin	Type	Status	App. Date	Grant Date	Expiration Date	Pros./Admin. Agent	Next Action Req.
				Subtype	Substatus	App. No.	Grant No.			Next Action Due
FTR0211/AU	<input type="checkbox"/>	Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023		Annuitiy : Next 19 Jun 2008
FTR0211/BR	<input type="checkbox"/>	Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023		Annuitiy : Next 19 Jun 2005
FTR0211/CA	<input type="checkbox"/>	Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023		Annuitiy : Next 19 Jun 2005
FTR0211/CN	<input type="checkbox"/>	Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023		
FTR0211/CZ	<input type="checkbox"/>	Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023		
FTR0211/EA	<input type="checkbox"/>	Patent Cooperation Treaty	ORIGIN	Patent	Inactive	19 Jun 2003	27 Oct 2006	19 Jun 2023		
FTR0211/EA/KZ	<input type="checkbox"/>	National Patent	ORIGIN	Patent	Granted	19 Jun 2003	27 Oct 2006	19 Jun 2023		
FTR0211/EA/RU	<input type="checkbox"/>	National Patent	ORIGIN	Patent	Granted	19 Jun 2003	27 Oct 2006	19 Jun 2023		
FTR0211/EP	<input type="checkbox"/>	European Patent Convention	ORIGIN	Patent	Inactive	21 Jun 2002	13 Jun 2007	21 Jun 2022		Office Action 07 Sep 2004
FTR0211/EP/BE	<input type="checkbox"/>	European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022		Annuitiy : Next 21 Jun 2007
FTR0211/EP/CH	<input type="checkbox"/>	European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022		Annuitiy : Next 21 Jun 2007
FTR0211/EP/DE	<input type="checkbox"/>	European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022		Annuitiy : Next 21 Jun 2007

Patent Family Record Sheet

FTR0211/EP/ES	<input type="checkbox"/> European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022	Annuity: Next
					02405517.0	EP1375127		21 Jun 2007
FTR0211/EP/FR	<input type="checkbox"/> European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022	Annuity: Next
					02405517.0	EP1375127		21 Jun 2007
FTR0211/EP/GR	<input type="checkbox"/> European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022	Annuity: Next
					02405517.0	EP1375127		21 Jun 2007
FTR0211/EP/IT	<input type="checkbox"/> European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022	
					71829/BEI2007	EP1375127		
FTR0211/EP/LU	<input type="checkbox"/> European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022	Annuity: Next
					02405517.0	EP1375127		21 Jun 2007
FTR0211/EP/NL	<input type="checkbox"/> European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022	Annuity: Next
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FTR0211/EP/PT	<input type="checkbox"/> European Patent Convention	ORIGIN	Patent	Granted	21 Jun 2002	13 Jun 2007	21 Jun 2022	Annuity: Next
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					02405517.0	EP1375127		21 Jun 2007
FTR0211/HK	<input type="checkbox"/> National Patent	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023	Foreign Filing Client Query patent
				Published	05111322.1			19 Mar 2004
FTR0211/HU	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023	First 3 annuities
				Published	P0500346			28 Sep 2005
FTR0211/ID	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Granted	19 Jun 2003	30 Jul 2007	19 Jun 2023	
					W00200402838	ID0019658		
FTR0211/IL	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023	
				Nat. Phase	165379			
FTR0211/JP	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023	
				Published	2004-514502			
FTR0211/KR	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023	Request examination and pay appropriate fee
				Nat. Phase	10-2004-7020663			19 Jun 2008
FTR0211/MX	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		19 Jun 2023	
				Published	PA/a/2004/012516			
FTR0211/PCT	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Inactive	19 Jun 2003		19 Jun 2023	Correction of Defects
				Children in national phase	PG/IT/CH03/00397			21 Sep 2003

Patent Family Record Sheet

FTR0211/PL	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003	19 Jun 2023	
				Nat. Phase	373769		
FTR0211/SG	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Granted	19 Jun 2003	30 Apr 2007	19 Jun 2023
					200407440-7	108633	21 Dec 2006
FTR0211/UA	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	19 Jun 2003		
				Nat. Phase	20041211030		
FTR0211/US	<input type="checkbox"/> Patent Cooperation Treaty	ORIGIN	Patent	Pending	20 Dec 2004		Rem 2mo - OA Resp. Due
				Published	10/518729		25 Apr 2008